REMARKS

The Office Action mailed on April 15, 2009, was received and its contents carefully reviewed. For the purposes of this Response, claims 14-18, 23-31, 36-39, and 49-55 are pending. Claims 1-13, 19-22, 32-35, and 40-48 were previously withdrawn in response to a Restriction Requirement. In the above amendments, Applicants amended claims 14 and 27 to provide additional context to the claims and to clarify the subject matter claimed in view of recent precedent regarding 35 U.S.C. § 101. Support for the amendments can be found throughout the Specification and Figures, such as in paragraphs [0016, 0043-0047, 0050-0055, 0057, 0060, 0062] of the Specification and Figures 1, 2, 15, and 18, for example. Applicants respectfully submit that no new matter was introduced by the amendments. Claims 14-18, 23-31, 36-39, and 49-55 remain pending and are believed to be in condition for allowance. Applicants respectfully request reconsideration of this application in light of the above amendments and the following remarks.

A. Overview

The present invention relates to a system and method for managing pharmacy benefits. The pharmacy benefits management system and method of the present invention receives claim information, pharmacy benefits formulary information, pharmacy benefits plan structure information, and drug price information and calculates and aggregates out-of-pocket costs, sponsor costs, and total costs of the dispensed drugs. The cost information determined by the system and method of the present invention provides patients, doctors, employers, insurance providers, and other stakeholders a basis for comparison of alternative drugs. With this information, pharmacy benefit costs may be minimized and pharmacy benefit plans may be efficiently managed. Previous systems employ distribution channels for prescription drugs that are separate from the payment channels. By tightly integrating the activities in the prescription drug benefit life cycle from prescribing to distributing to payment to reimbursement, improved cost control may be implemented while maximizing drug benefits.

B. Examiner Interview

Applicants thank Examiner Porter for her consideration during the telephone interview conducted on June 25, 2009. In the interview, Applicants' representative provided

proposed amendment language with regard to the claim rejections under 35 U.S.C. § 101. Additionally, Applicants' representative and Examiner Porter discussed the outstanding claim rejections with regard to 35 U.S.C. §§ 112 and 103. Applicants' representative provided a brief explanation of the invention and highlighted the differences between the present invention and the references cited in the Office Action mailed April 15, 2009. Applicants amended a number of claims above to provide further context to the claims and to clarify the subject matter claimed.

C. Drawings

Applicants' representative discussed the status of the Drawings with Examiner Porter during the telephone interview conducted on June 25, 2009. In the interview, Examiner Porter agreed to hold any necessary corrections to the drawings in abeyance until no additional objections remain in the present application.

D. Claim Rejections under 35 U.S.C. § 101

Claims 27-31, 36-39 and 49-52 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants amended independent claim 27 above to clarify the features of the present invention in view of recent court decisions. As such, Applicants respectfully request reconsideration of these claims and withdrawal of the rejection under 35 U.S.C. § 101. The amended claims are directed to statutory subject matter in view of Supreme Court precedent and recent decisions of the United States Court of Appeals for the Federal Circuit.

The Patent Statute reads:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 101. The statute thus recites four categories of patent-eligible subject matter, namely processes, machines, manufactures, and compositions of matter. Applicants invented a method, system, and computer program product for automating purchase requests that is tied to a computer system and that changes the state of computer readable data stored on a recording medium by performing routing actions on submitted purchase requests. *See In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). As the Court of Appeals for the Federal Circuit

(CAFC) recently reiterated, "[A] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *See In re Bilski*, 545 F.3d 943, (Fed. Cir. 2008) (quoting Gottschalk v. Benson, 409 U.S. 63, 70 (1972) ("Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines."). *Diamond v. Diehr*, 450 U.S. 175, 192 (1981) (holding that use of mathematical formula in process "transforming or reducing an article to a different state or thing" constitutes patent-eligible subject matter); *see also Parker v. Flook*, 437 U.S. 584, 589 n.9 (1978) ("An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing.'").

Amended independent claim 27 of the present application recites a process tied to computer devices that transforms received claim information, pharmacy benefits formulary information, pharmacy benefits plan structure information, and drug price information to calculate and aggregate out-of-pocket costs, sponsor costs, and total costs of drugs dispensed to patients. As such, amended claim 27 falls within the four categories of patent-eligible subject matter. As amended, each of claims 27-31, 36-39 and 49-52 of the present application meets the "machine-or-transformation" test outlined by the CAFC in *Bilski* because they each recite at least a method tied to a particular machine or they transform an article into a different state. As such, Applicants respectfully request reconsideration of claims 27-31, 36-39 and 49-52 and the withdrawal of the rejection of claims 27-31, 36-39 and 49-52 under 35 U.S.C. § 101.

In the present application, out-of-pocket costs, sponsor costs and total costs of the drugs dispensed to patients are calculated and aggregated from disparate sources of claim, formulary, pharmacy benefits plan structure, and price information. The different information received is instantiated in a management server that calculates and aggregates the cost information. See paragraphs [0016, 0043-0047, 0050-0055, 0057, 0060, 0062] of the Specification and Figures 1, 2, 15, and 18, and throughout the Specification and Figures. The method for pharmacy benefits management produces out-of-pocket costs, sponsor costs, and total costs according to numerous considerations, such as plan information, formulary information, and the like. The pharmacy benefits claims are transformed to reveal out-of-pocket costs, sponsor costs, and total costs by the actions performed upon them by the

various computing devices of the pharmacy benefits management system recited in amended independent claim 27.

As such, amended claim 27 meets the "transformation" aspect of the "machine or transformation" test outlined by the Court of Appeals for the Federal Circuit in the *Bilski* case and falls within the classes of new and useful processes, machines, manufactures, or compositions of matter that are the proper subject matter of a patent under 35 U.S.C. § 101. The method for pharmacy benefits management recited in amended claim 27 meets both criteria of the two branched "machine-or-transformation test," outlined by the Court of Appeals for the Federal Circuit in the *Bilski* case. Applicants need only show that a [method] claim satisfies § 101 either by showing that the claim is tied to a particular machine, or by showing that the claim transforms an article. *See Gottschalk v. Benson*, 409 U.S. 63, 70 (1972) (emphasis added). Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 27 under 35 U.S.C. § 101.

Claims 28-31, 36-39, and 49-52 of the present application depend upon amended independent claim 27 and thereby include all the limitations of claim 27 while reciting additional features of a method of the present invention. Applicants respectfully traverse the rejection of claims 28-31, 36-39, and 49-52 for similar reasons as outlined above with regard to the rejection of claim 27 under 35 U.S.C. § 101. As discussed above, amended claim 27 recites a method of the present invention that falls within the purview of 35 U.S.C. § 101. The additional features and limitations of claims 28-31, 36-39, and 49-52 do not make these claims non-statutory. Accordingly, Applicants respectfully submit that claims 28-31, 36-39, and 49-52 comply with 35 U.S.C. § 101 as outlined above with regard to claim 27. Applicants respectfully request reconsideration and reversal of the rejection of claims 28-31, 36-39, and 49-52 under 35 U.S.C. § 101.

E. Claim Rejections under 35 U.S.C. § 112

Claims 14-18, 23-31, 36-39 and 49-55 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Additionally, claims 14-18, 23-26 and 53-55 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Based upon the telephone interview discussions

and the remarks below, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112.

1. Claims 14-18, Claims 23-31, Claims 36-39, and Claims 49-55 Comply with the Written Description Requirement under 35 U.S.C. § 112, first paragraph.

Independent claim 14 recites a pharmacy benefits management system that includes pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, management means for receiving pharmacy benefits formulary information and price information relating to drugs in various classes, and provider means for receiving pharmacy benefits plan structure information. See Figure 1 and paragraphs [0016, 0045-0054] and especially paragraphs [0049 and 0050]. Additionally, the management means calculates and aggregates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, the received price information, the identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug. See paragraphs [0050-0058, 0061-0066] and Figures 2, 7, 8, 10A, 10B, 11, 14, 15, and 20.

In the Office Action mailed April 15, 2009, the Examiner asserts that "Claims 14 and 27 recite limitations that are new matter, and are therefore rejected. The respective dependent claims inherit the deficiency through dependency and are therefore also rejected." See page 5, paragraph 6 of the Office Action mailed April 15, 2009. The Examiner asserts that the calculating and aggregating steps performed by the management server are not supported in the specification as originally filed.

As discussed in the telephone interview on June 25, 2009, and in Applicants' numerous responses filed after the initial personal interview conducted at the U.S. Patent and Trademark Office on March 29, 2006, Applicants amended independent claims 14 and 27 to include the above features after discussing proposed amendment language related to the system and method of the present invention. The calculating and aggregating steps are performed by the pharmacy benefits management system of the present invention after taking pharmacy benefit claim information, formulary information, price information, and pharmacy benefits plan structure information (e.g., deductible, co-payment, subscriber identification)

for a particular time period and processing these numerous costs, constraints, and rules to determine out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed. See paragraphs [0048-0051] of the present specification. The costs are calculated based upon the various information received and the structure of the plan and identity of the subscriber. The costs are then aggregated and presented for review. See paragraphs [0050 and 0051] of the present specification.

Specifically, paragraph [0050] of the present specification describes the completion of the registration process (Figure 2) and displaying a pharmacy benefits summary of the registered recipient. "The summary includes out of pocket costs 258 for the appropriate time period (such as the current calendar year) and sponsor costs 262 assumed by the plan sponsor for recipient's pharmacy benefits for that same time period." The disclosure in paragraph [0050] also notes, "... PBM server 120 includes benefit information 124 relating to pharmacy benefits, provided to recipients, such as the type of drug dispensed, the identity of the pharmacy dispensing the drug, the identity of the doctor dispensing the drug, and the like. Also, PBM server 120 includes formulary information 122. This information can be processed by management server 110 to present out of pocket costs 258 and sponsor costs 252." See paragraph 0[50] of the present application (emphasis added).

Additional details with regard to calculating costs are disclosed in the original specification in paragraphs [0051-0054] including:

> The screen illustrated in FIG. 8. provides a list of each drug dispensed to recipient (as an individual) under the pharmacy benefit plan in column 266 as well as the date of dispensing in column 272, the recipient's out of pocket costs (such as copayment) for that drug in column 274, and the plan sponsor costs in column 276. Once again, this information is culled from benefit information 124 stored in PBM server 120 and processed by management server 110 for presentation on recipient client 140.

See paragraph [0051] of the present specification (emphasis added).

As described in at least paragraphs [16 and 0048-0054] of the present specification, Applicants respectfully submit that there is proper support for the pharmacy benefits management system recited in claim 14 and the pharmacy benefits management method recited in claim 27 of the present application, including the calculating and aggregating steps recited.

Additionally, claims 15-18, 23-26, and 53-55 depend upon independent claim 14, while claims 28-31, 36, 37, and 52 depend upon independent claim 27 while reciting other features of the present invention. As such, Applicants respectfully submit that the claimed

subject matter is properly described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully request reconsideration of claims 14-18, 23-31, 36-39, and 49-55 withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

2. Claims 14-18, Claims 23-26, and Claims 53-55 Particularly Point Out and Distinctly Claim the Subject Matter Comply of the Invention under 35 U.S.C. § 112, first paragraph.

Claims 14-18, claims 23-26, and 53-55 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as indicated beginning on page 6 of the Office Action mailed April 15, 2009. Applicants respectfully submit that these claims of the present application distinctly recite the subject matter that Applicants regard as the invention.

In the Office Action mailed April 15, 2009, the Examiner indicated that the "management means" feature of claim 14 is a means (or step) plus function that invokes 35 U.S.C. § 112, sixth paragraph but indicated that the written description fails to clearly link or associate the disclosed structure material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. In particular, the Examiner indicated that it is not clear that the management means or any particular component calculates out-of-pocket costs, sponsor costs, and total costs.

As indicated above with regard to the rejection under 35 U.S.C. § 112, first paragraph, the present Specification is replete with examples of a management server used to (among other things) calculate and aggregate the out-of-pocket costs, sponsor costs, and total costs of drugs dispensed to patients based upon the information received. See, for example, paragraphs [0016 and 0042-0047, 0050-0062] of the present Specification as well as Figure 1, reference element 110, Figures 2, 15, and 18, and also the explanation above with regard to the rejection under 35 U.S.C. § 112, first paragraph.

In the Office Action, the Examiner also indicated that dependent claims 15-18, 23-26, and 53-55 inherit the deficiencies of independent claims 14 and 27 and are also rejected. The Examiner required Applicant(s) to: "(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. § 112, sixth paragraph;

or (b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. § 132 (a)); or (c) state on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function." However, the Examiner has not cited any authority for this requirement.

With respect, the present Specification includes an explicit description of a management server used in carrying out the method recited in independent claim 27. The means for carrying out the method are recited in independent system claim 14. One of ordinary skill in the art may quickly identify the structure, material, or acts disclosed in the written description of the Specification that perform the claimed function. These structures, materials, and acts are disclosed at least in paragraphs [0016 and 0042-0047, 0050-0062] of the present Specification as well as Figure 1, reference element 110, and Figures 2, 15, and 18.

As such, Applicants respectfully submit that the claimed subject matter is properly described in the specification in such a way as to reasonably convey to one skilled in the relevant art the structure, material, or acts disclosed in the written description of the Specification that perform the claimed function. Applicants respectfully request reconsideration of claims 14-18, 23-26, and 53-55 withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

F. Claim Rejections under 35 U.S.C. § 103

Claims 14-18, 23-31, 36-39, and 49-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pack-Harris U.S. Patent Number 6,195,612 ("the Pack-Harris patent") in view of Mayaud U.S. Patent Number 5,845,255 ("the Mayaud patent") and further in view of Lencki et al., U.S. Patent Publication No. 2002/0049617 ("the Lencki application") as indicated beginning on page 8 of the Office Action mailed April 15, 2009. In view of the amendments above and the comments below, Applicants respectfully request reconsideration of these claims and withdrawal of the rejection because the combination of the Pack-Harris patent, the Mayaud patent, and the Lencki application fails to disclose or suggest all the elements recited in the pending claims and fails to make the claimed invention unpatentable as obvious under 35 U.S.C. § 103(a).

1. The Pack-Harris Patent Describes a Conventional Pharmacy Benefits System that does not Include all Recited Features of Claims 14-18, 23-31, 36-39, and 49-55 of the Present Application.

As outlined above, the present invention generally relates to a pharmacy benefits management system and method that receives claim information, pharmacy benefits formulary information, pharmacy benefits plan structure information, and drug price information and calculates and aggregates out-of-pocket costs, sponsor costs, and total costs of the dispensed drugs. The cost information determined by the system and method of the present invention provides patients, doctors, employers, insurance providers, and other stakeholders a basis for comparison of alternative drugs. With this information, pharmacy benefit costs may be minimized and pharmacy benefit plans may be efficiently managed.

The system described by the Pack-Harris patent, on the other hand, provides a medical group with costs and utilization rates by individual physicians and by the medical group relative to pharmacy benefit capitation (see col. 2, lines 26-32 of the Pack-Harris patent). The system of the Pack-Harris patent provides a medical group with information regarding the drugs obtained and their actual costs based on the prescription activity of the medical group physicians (see col. 2, lines 33-38). This is quite different from the present invention, which is directed to providing pharmacy management information to the actual recipient consumer of the health care benefits so that the user may examine what is being charged for the prescription drugs with complete market transparency. The system of the Pack-Harris patent provides information regarding the drugs obtained to the physician making the prescribing decision.

a. Pharmacy Benefits Means

Independent claims 14 and 27 of the present application recite a pharmacy benefits management system comprising pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, where the claim information includes identification of drugs dispensed to individual patients.

The Pack-Harris patent describes a system that uses a pharmacy computer that generates pharmacy claim information when prescriptions are filled at those pharmacies. See col. 3, lines 20-25 of the Pack-Harris patent. A health care plan computer generates medical group prescription information for the participating medical group. See col. 3, lines 29-34.

The prescription information provided by these two computers in the Pack-Harris patent merely collects the prescription information for that particular medical group to generate and present utilization information indicative of the prescription activity for the medial group, so that the group may monitor their prescription activity relative to pharmacy benefit capitation. See col. 3, lines 35-37; lines 46-54.

The Pack-Harris patent does not disclose or suggest pharmacy benefit means that receives claim information processed by a claims processing facility, but rather a medical group computer that receives prescription information corresponding to the medical group and not to drugs dispensed to the patient as recited in the independent claims of the present application. The information received by the system of the Pack-Harris patent provides the medical group with a view of their prescription activity, not the prescription activity of the individual patient.

b. Provider Means

Claims 14 and 27 of the present application recite provider means for receiving pharmacy benefits plan structure information including deductible information and co-payment information to determine a recipients' prescription benefit plan and identify the subscriber of the prescription benefit plan.

The Examiner refers to column 3, lines 10-34 of the Pack-Harris patent in asserting that the provider means are disclosed. However there is no disclosure or suggestion of such provider means in the Pack-Harris patent. The cited portion of the Pack-Harris patent disclose only the pharmacy computer that provides pharmacy claim information when prescriptions are filled, the health care plan computer that generates the medical group prescription information, and the medical group computer that generates utilization information indicative of the prescription activity for the medial group relative to pharmacy benefit capitation. In a capitation scenario, the medical group is paid a flat amount for each patient. The medical group will earn less for a relatively sick population that requires more prescription medication than the medical group would earn for a relatively healthy population of patients that would require less prescription medication. The system of the Pack-Harris patent enables the medical group to track their prescription activity relative to the benefit capitation. See col. 1, lines 25-35; lines 45-59.

In contrast, independent claims 14 and 27 of the present application recite provider means that receive benefit plan structure information including deductible information and co-payment information and determine a recipient's prescription benefit plan and identify the subscriber of the plan. The provider means receive benefit plan structure information related to the patient (subscriber) and not to the medical group. Further, in the Pack-Harris patent, there is no disclosure or suggestion of provider means receiving deductible or co-payment information.

c. Management Means

Claims 14 and 27 of the present application recite management means for receiving pharmacy benefits formulary information and price information relating to drugs in various classes. The management means recited in these independent claims also calculate out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information.

Additionally, claims 14 and 27 recite that the management means further aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug. Likewise, claims 14 and 27 recite that the management means causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

The Examiner refers to column 12, lines 7-15 and Figures 18, 19, and 39 of the Pack-Harris patent in asserting that the management means are disclosed. However there is no disclosure or suggestion of management means that calculate the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the prescription benefit plan, the subscriber, the claim information, the formulary information, the benefit plan structure, and the price information in the Pack-Harris patent. The cited Figures and corresponding discussions in the Pack-Harris patent disclose only a list of the top eight classes of drugs prescribed by the physician in the medical group, the number of prescriptions for each drug, and the corresponding cost for the prescription identified. See Figure 18 and col. 9, lines 21-29 of the Pack-Harris patent. Similarly, Figure 19 breaks this list down by the

yearly quarter that the prescriptions were written. Figure 39 and the accompanying text in col. 12, lines 7-15 of the Pack-Harris patent shows a list of patients, their social security numbers, their insurance group ID, their provider ID, and their insurance plan, but there is no disclosure or suggestion of management means that calculates and aggregates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the prescription benefit plan, the subscriber, the claim information, the formulary information, the benefit plan structure, and the price information. The system of the Pack-Harris patent enables the medical group to track their prescription activity by quarter relative to the benefit capitation, but does not disclose or suggest the specific management means recited in claims 14 and 27 of the present application.

Independent claims 14 and 27 of the present application recite management means that calculate out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. The management means then aggregate out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the identity of drug dispensed, the type of drug dispensed, formulary information, the identity of pharmacy dispensing drug, and the identity of doctor prescribing drug. Likewise, claims 14 and 27 recite that the management means causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits. The focus is on providing both out-of-pocket costs that a prescription recipient may receive as well as the sponsor costs borne by an employer or other third party payer. With this information, the recipient may evaluate total costs of the particular drug benefit. Similarly, the recipient and sponsor may collaborate to determine the efficacy of the offered prescription drug benefit.

In the Pack-Harris patent, there is no disclosure or suggestion of such management means performing these steps. Instead, the Pack-Harris patent discloses only the prescription cost of a particular drug. Nowhere does the Pack-Harris patent evaluate and disclose the out-of-pocket costs and sponsor costs of a particular drug benefit.

2. The Mayaud Patent Fails to Cure the Deficiencies of the Pack-Harris Patent and does not Include all Recited Features of Claims 14-18, 23-31, 36-39, and 49-55 of the Present Application.

The Mayaud patent fails to cure the deficiencies of the Pack-Harris patent. The Examiner cited the Mayaud patent to allegedly disclose pharmacy benefits formulary information, but the Mayaud patent is an electronic prescribing tool used to improve the quality of prescriptions written (see col. 4, lines 21-26 of the Mayaud patent). While the Mayaud patent discloses in col. 13, lines 49-56 that the data may be aggregated for multiple users and that an individual user's prescribing pattern may be reviewed by the user or by others for formulary compliance, ensuring formulary compliance is not the same as structuring information related to a formulary multi-tier benefits program as recited in the present claims. Further, the environment in which the Mayaud patent may be practiced is not that of a drug benefit recipient or an employer seeking market transparency to control prescription drugs costs, but rather the "user" of the Mayaud patent is a physician or physician group seeking to provide additional details when they prescribe medication.

Further, there is no disclosure in the Mayaud patent of management server means that calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information as recited in amended independent claims 14 and 27 of the present application. The present invention brings the consumer of pharmacy benefits into the drug selection process by providing decision support as to the prescribed and available drugs. The pharmacy benefit recipient is at the center of the present invention, and aggregated out-of-pocket costs and sponsor costs are displayed to the recipient of the prescription benefits. In the Mayaud patent, there is no recipient listed as a "user." Instead, physicians and physician groups are the system users.

The recited features of claims 14 and 27 are not disclosed or suggested in either the cited Pack-Harris patent or the Mayaud patent, nor is there any suggestion or motivation to modify the system of the Pack-Harris patent with the Mayaud patent to produce Applicants' system and method recited in independent claims 14 and 27 of the present application.

In the Office Action mailed April 3, 2008, the Examiner asserts that, "At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary

benefits." See page 9 of the Office Action mailed April 15, 2009. Yet, the combination of the Pack-Harris patent with the Mayaud patent fails to disclose or suggest all the features recited in claims 14 and 27 of the present application. As such, Applicants respectfully submit that the combination of the Pack-Harris patent and the Mayaud patent fails to disclose or suggest all the elements and limitations recited in independent claims 14 and 27 of the present application and fails to render claims 14 and 27 obvious under 35 U.S.C. § 103(a).

3. The Lencki Application Fails to Cure the Deficiencies of the Combination of the Pack-Harris Patent and the Mayaud Patent and does not Include all Recited Features of Claims 14-18, 23-31, 36-39, and 49-55 of the Present Application.

The Lencki application fails to cure the deficiencies of the Pack-Harris patent and the Mayaud patent. The Examiner cited the Lencki application to allegedly disclose management means that perform the calculating, aggregating, and display steps recited in independent claims 14 and 27 that the Examiner conceded were not disclosed by the combination of the Pack-Harris and Mayaud patents. See page 9 of the Office Action mailed April 15, 2009. Specifically, the Examiner asserts that the Lencki application discloses a method and system as recited by claims 14 and 27 of the present application for calculating out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information.

Additionally, claims 14 and 27 recite that the management means further aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug. Likewise, claims 14 and 27 recite that the management means causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

The Lencki application, in fact, discloses a system and method for selecting employee benefits from a cafeteria-style benefits plan using an Internet-based tool. See paragraph [0002] of the Lencki application. In the Lencki application, an employee uses a Web-based program to identify a price for an item in a benefit category available for purchase. See paragraph [0010]. Employers provide benefit offerings to the employee, and employees are

able to choose the benefit offerings they wish to purchase. See paragraph [0080]. Employees use the Internet-based software to select and customize their benefits package to select a benefit package that fits their needs and those of their families. See paragraphs [0084 and 0091]. Employers control costs of administering the benefits and are better able to predict costs while providing maximum flexibility to the employees. See paragraphs [0084 and 0089].

The Lencki application does not disclose or suggest a management means that calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information as recited in amended independent claims 14 and 27 of the present application. The Examiner points to Figures 22B-E and paragraphs 89-91, 118, and 127 of the Lencki application as disclosing this claimed element, but this portion of the Lencki application merely describes providing consumer choice and a defined contribution strategy for the employer and access to the [healthcare] provider community for the employee from which they may construct their benefits package. See paragraphs [0089-0091]. The Lencki application further discloses that an employee can design her family's benefits package, including selecting a modified pharmacy benefit program. See paragraph [0118 and 0127]. There mere mention of selecting a modified pharmacy benefit program is not the same as disclosing means that calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information as recited in amended independent claims 14 and 27 of the present application.

Likewise, there is no mention of management means that aggregates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the identity of drug dispensed, the type of drug dispensed, formulary information, the identity of pharmacy dispensing drug, and the identity of doctor prescribing drug. The Examiner provides no additional details as to how these claimed elements and steps are met other than to point to the same portions of the Lencki application.

The recited features of claims 14 and 27 are not disclosed or suggested in either the Pack-Harris patent, the Mayaud patent, nor the Lencki application. In the Office Action

mailed April 15, 2009, the Examiner asserts that, "At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Pack-Harris and Mayaud in combination with the teachings of Lencki." See page 10 of the Office Action mailed April 15, 2009. Yet, the combination of the Pack-Harris patent, the Mayaud patent, and the Lencki application fails to disclose or suggest all the features recited in claims 14 and 27 of the present application. As such, Applicants respectfully submit that the combination of the Pack-Harris patent, the Mayaud patent, and the Lencki application fails to disclose or suggest all the elements and limitations recited in independent claims 14 and 27of the present application and fails to render claims 14 and 27 obvious under 35 U.S.C. § 103(a).

4. The Combination of References does not Disclose or Suggest All Recited Features of Claims 14-18, 23-31, 36-39, and 49-55 of the Present Application.

The Examiner fails to meet the burden of showing that each and every feature is disclosed by the combination of prior art references, or under 35 U.S.C. § 103(a), that it would have been obvious to combine prior art references to produce the recited claims of the present application. As such, Applicants respectfully submit that the Examiner has not shown that Applicants' invention would have been obvious under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully submit that claims 14 and 27 of the present application are allowable over the combination of prior art as outlined above. Applicants respectfully request reconsideration of claims 14 and 27 and withdrawal of the rejection under 35 U.S.C. § 103(a).

5. The Rejection of Dependent claims 15-18 and Dependent Claims 23-26 under 35 U.S.C. § 103(a) should also be Withdrawn.

Claims 15-18, 23-26, 28-31, 36-39, and 49-55 of the present application depend upon independent claims 14 and 27, respectively, and thereby include all the limitations of claims 14 and 27, respectively, while reciting additional features of a system of the present invention. Applicants respectfully submit that the rejection of claims 15-18, 23-26, 28-31, 36-39, and 49-55 is improper under 35 U.S.C. § 103(a) for similar reasons outlined above with regard to the rejection of claims 14 and 27. As discussed above, the combination of cited references fails to disclose or suggest all the elements and limitations recited in

independent claims 14 and 27 of the present application and fails to render claims 14 and 27 obvious under 35 U.S.C. § 103(a). Therefore, the combination of applied references also fails to disclose all the features and limitations of dependent claims 15-18, 23-26, 28-31, 36-39, and 49-55, as well, and also fails to render claims 15-18, 23-26, 28-31, 36-39, and 49-55 obvious under 35 U.S.C. § 103(a). As such, Applicants respectfully request reconsideration of claims 15-18, 23-26, 28-31, 36-39, and 49-55 and withdrawal of the rejection under 35 U.S.C. § 103(a).

G. Conclusion

In view of the above amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application and the timely allowance of the pending claims. Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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